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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|----------------------|----------------------------|------------------------|
| 09/476,711 | 12/30/1999 | DAVID O. MCGOVERAN | | 8198 |
| 7590 GEORGE S COLE 495 SEAPORT COURT SUITE 101 REDWOOD CITY, CA 94063 | | 02/07/2007 | EXAMINER BOYCE, ANDRE D | |
| | | | ART UNIT 3623 | PAPER NUMBER |
| | | | MAIL DATE 02/07/2007 | DELIVERY MODE PAPER |

Please find below and/or attached an Office communication concerning this application or proceeding.

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|--|-------------------------|---------------------|--|
| Advisory Action Before the Filing of an Appeal Brief | Application No. | Applicant(s) | |
| | 09/476,711 | MCGOVERAN, DAVID O. | |
| | Examiner Andre Boyce | Art Unit 3623 | |
| --The MAILING DATE of this communication appears on the cover sheet with the correspondence address -- | | | |
| THE REPLY FILED 05 January 2007 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. | | | |
| <p>1. <input checked="" type="checkbox"/> The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:</p> <p>a) <input checked="" type="checkbox"/> The period for reply expires <u>5</u> months from the mailing date of the final rejection.</p> <p>b) <input type="checkbox"/> The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.</p> <p>Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).</p> | | | |
| <p>Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).</p> | | | |
| <p>NOTICE OF APPEAL</p> <p>2. <input type="checkbox"/> The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).</p> | | | |
| <p>AMENDMENTS</p> <p>3. <input type="checkbox"/> The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, <u>will not</u> be entered because</p> <p>(a) <input type="checkbox"/> They raise new issues that would require further consideration and/or search (see NOTE below);</p> <p>(b) <input type="checkbox"/> They raise the issue of new matter (see NOTE below);</p> <p>(c) <input type="checkbox"/> They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or</p> <p>(d) <input type="checkbox"/> They present additional claims without canceling a corresponding number of finally rejected claims.</p> <p>NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).</p> | | | |
| <p>4. <input type="checkbox"/> The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).</p> <p>5. <input type="checkbox"/> Applicant's reply has overcome the following rejection(s): _____. </p> | | | |
| <p>6. <input type="checkbox"/> Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).</p> | | | |
| <p>7. <input checked="" type="checkbox"/> For purposes of appeal, the proposed amendment(s): a) <input type="checkbox"/> <u>will not</u> be entered, or b) <input checked="" type="checkbox"/> <u>will</u> be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.</p> <p>The status of the claim(s) is (or will be) as follows:</p> <p>Claim(s) allowed: _____. </p> <p>Claim(s) objected to: _____. </p> <p>Claim(s) rejected: <u>112-190 and 192</u>. </p> <p>Claim(s) withdrawn from consideration: _____. </p> | | | |
| <p>AFFIDAVIT OR OTHER EVIDENCE</p> <p>8. <input type="checkbox"/> The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal <u>will not</u> be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).</p> <p>9. <input type="checkbox"/> The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, <u>will not</u> be entered because the affidavit or other evidence failed to overcome <u>all</u> rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).</p> <p>10. <input type="checkbox"/> The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.</p> | | | |
| <p>REQUEST FOR RECONSIDERATION/OTHER</p> <p>11. <input checked="" type="checkbox"/> The request for reconsideration has been considered but does NOT place the application in condition for allowance because: <u>See Continuation Sheet.</u></p> <p>12. <input type="checkbox"/> Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). _____</p> <p>13. <input type="checkbox"/> Other: _____.</p> | | | |

Continuation of 11. does NOT place the application in condition for allowance because: With respect to the rejections under 35 USC § 112, Applicant argues that claim 112 is concrete because the result (i.e., the objective) is stated as a set of measurable goals and constraints and rules are also stated to accomplish at least a part of said objective by the combination of at least one subset of the rules. In addition, Applicant contends that the claimed invention can be used as intended without undue experimentation, because constraints and rules are specified during the process defined by the claim such that the result is concrete if the specified action is executed when the conditions and constraints are satisfied.

The Examiner submits that while the objective may be stated as a set of measurable goals and constraints, the claimed invention still lacks concreteness, because the "objective," although stated as a set of measurable goals and constraints, may not be assured, reproducible, and could be impossible. Here, the "objective" is very broad and can encompass seemingly anything, thus leading to a result that is neither assured nor reproducible, since the claim language does not describe, for example, how the objective is determined, who determines the objective, what area of art the objective is related to, what the objective accomplishes, the context of the objective, etc.

As an example, someone intending to practice the invention could set an objective of "find a cure for cancer in 6 months," and state that objective as a set of measurable goals and constraints, declare and state objective rule sets, delegate specific actors, etc., and still end up with a result that is neither assured nor reproducible, but likely impossible. As a result, the claimed invention indeed lacks concreteness and remains rejected under 35 USC § 112 and 35 USC § 101, because of the vagueness and broadness of the "objective."

O S
ANDREW BOYCE
PATENT EXAMINER
A.U. 3623